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09/506,261	02/17/2000	Dennis Palatov	MGANO-010A	7408

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EXAMINER

TRAN, HAI V

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/506,261

Applicant(s)

PALATOV ET AL.

Examiner

Hai Tran

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30,32-34 and 36-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30,32-34 and 36-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 30-62 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 37-38, 42, 44-45 are rejected under 35 U.S.C. 102(b) as being unpatentable by Cantone (US 5734781).

Regarding claim 37, Cantone discloses a handheld dedicated secure (the data is automatically erased after the period is expired or Data could only be viewed within the allowed period; thus, the content is secured and no-one could access/use) video content storage device (Fig. 1) comprising:

A mass storage module 12 configured to store at least about an hour (duration of at least 1 hour for most movie; Col. 5, lines 55-59) of at least television suitable quality digitally encoded video content (compressed digital data Col. 2, lines 20-30);

A controller 22 configured to prevent unauthorized access to the mass storage module (authorized access only within the rental period; Col. 5, lines

58-Col. 6, lines 4), the controller further configured to permit video content to be written to the mass storage module by compatibility configured interactive kiosk (Distribution Center/Video Server; Col. 5, lines 48-56);

A hand-held housing 20 containing the mass storage module 12 and the controller 22;

A communication port 18 (Col. 3, lines 40-55) mounted in the housing, the communication port configured to be re-movably connected to the interactive kiosk to thereby establish communication (Col. 5, lines 48-56 and Col. 6, lines 38-51) with the interactive (since user has to request and select movie to be recorded) kiosk (Distribution Center/Video Server).

Regarding claim 38, Cantone further discloses wherein the communication port comprises an electrical connector 18 (data port; Col. 3, lines 40-43).

Regarding claim 42, Cantone further discloses wherein the mass storage module 12 is a disk drive (Col. 2, lines 66-Col. 3, lines 1).

Regarding claim 44, Cantone controller must comprises a data buffer configured to bugger data as the data is transferred to or from the disk since the incoming and outgoing of data from the storage module 12 must be digitally compressed and decompressed through the controller 22 (Col. 3, lines 43-53);

Regarding claim 45, Cantone discloses further comprising stored content use data relating to the use of video content stored on the mass storage module (Col. 5, lines 63-Col. 6, lines 4);

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 30-34, 36-43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (US 5909638) in view of Tatebayashi et al. (US 6182215 B1) and further in view of Peterson Jr. (US 5825876).

Regarding claim 30, Allen discloses a system for distributing video content (Fig. 1, Abstract), the system comprising:

An interactive kiosk configured to be located in a public location (fig. 16) (Col. 22, lines 15-40), the kiosk further configured to receive and access/read the data/video content storage *device* (VHS videotape, recordable laser disk or DVD, see Col. 1, lines 25-32).

Allen does not clearly disclose the kiosk further configures to securely store video content on the portable video content storage device upon which digitally encoded video content is securely stored to prevent unauthorized access; a set-top box configured to receive the portable video content storage device, to access/write the securely stored video content from the portable video content storage device and to provide the video content as an output signal to a video display.

Tatebayashi describes a method to securely store video content on the portable video content storage device upon which digitally encoded video

content is securely stored (using encryption method to store information/data on the portable device) and to prevent unauthorized access by using authentication protocol (Col. 5, lines 65-Col. 6, lines 11). Tatebayashi further discloses a set-top box (Fig., 2; elements 101 and Fig. 5, element 101 as a broadcast satellite receiver; see col. 10, lines 15-47) configures to receive the portable video content storage device to access the securely stored video content from the portable video content storage device and to provide the video content as an output signal to a video display (Once, the authentication protocol is verified, the access is authorized to perform any functions required to display necessary on any display device; i.e., TV, computer monitor). Furthermore, "A portable video content storage devices" is defined as any portable apparatus to store data/video information and it could be carried by users; i.e., portable VCR/DVD/CD device, VHS tape, removable digital computer Hard Disk drive, CD/DVD disk or cartridge medium, PCs, Laptop, PCMCIA card with integrated storage, etc... Fig., 2; elements 104, 105, 106, 102, 103 and Fig. 4, element 104). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Allen's system to securely configure the kiosk to securely store video content on the portable video content storage and to prevent unauthorized access to stored video content on the portable video content storage device, as taught by Tatebayashi, so to prevent the video productions/recording from being distributed to unauthorized devices (Col. 1, lines 47-50).

Allen and Tatebayashi do not clearly disclose wherein the set-top box is configured to write content use data to the portable video content storage device.

Peterson discloses Fig. 1, a method of controlling access to a secured data content of a storage medium 10 and is configured to write content use data to the "portable storage device" (secure card 42; Col. 8, lines 40-Col. 9, lines 10) through an authentication method. Therefore, it would have been obvious to an ordinary skill in the art at the time the invention was made to modify Allen in combination with Tatebayashi to write content use data to a portable storage device, as suggested by Peterson, so to keep track and limit the usage/access of the content according to the authorized list 56 whereby revenue generation from distribution thereof is expended are desirable (Col. 2, lines 12-15 and Col. 10, lines 30-35).

Regarding claim 32, Tatebayashi further discloses wherein the portable video content storage device consists essentially of passive storage media unit (Col. 8, lines 5-15).

Regarding claim 33, both Tatebayashi (Col. 5, lines 65-Col. 6, lines 11) and Peterson (Col. 3, lines 27-29 and col. 5, lines 50-58; Fig. 1, elements 28 and 30) disclose encoded video content stored on the storage medium is encrypted to prevent unauthorized access.

Regarding claim 34, the method claim 34 is analyzed with respect to apparatus claim 30.

Regarding claim 36, with the teaching of Tatebayashi and Peterson, Allen's kiosk system is clearly able to read content use data stored from the portable video content storage device so to complete billing service at the central distribution site (Col. 3, lines 9-10).

Regarding claim 37, the hand-held dedicated secure video content storage device is analyzed with respect to claim 30. The communication port mounted in the housing of Tatebayashi's devices (Fig. 1, 2; elements 104, 105, 106, 102, 103) is obvious to be removable configured to connect/disconnect to the Kiosk.

Peterson further discloses the controller could be configured as a substitute to utilize the combination of a secure card and a card reader/writer (Col. 11, lines 55-58) to prevent unauthorized access to mass storage media 10. Therefore, it would have been obvious to an ordinary skill in the art at the time the invention was made to modify Tatebayashi's portable devices by having a controller configured, as taught by Peterson, so to prevent authorized access to a mass storage media as discloses by Perterson.

Regarding claim 38, Tatebayashi's devices (Fig. 1, 2; elements 104, 105, 106, 102, 103) further discloses wherein the communication port comprises an electrical connector (fig., element 107).

Regarding claim 39, Tatebayashi fails to show the communication port comprise an optical connector.

Official Notice is taken that the use of an optical connector is well known in the art. Therefore, it would have been obvious to one of ordinary



skill in the art at the time the invention was made to modify Tatebayashi by including an optical connector so to provide a more choice of connectivity between devices.

Regarding claims 40, Tatebayashi further discloses an authentication scheme to communicate with only devices that have a reference authentication table pre-configured (Col. 5, lines 65-Col. 6, lines 60).

Regarding claim 41, see analysis of claim 30 in combination with claim 40.

Regarding claim 42, Tatebayashi's devices (Fig. 1, 2; elements 104, 105, 106, 102, 103) all have a disk drive.

Regarding claim 43, with the teaching of Tatebayashi ' authentication protocols (Col. 8, lines 15-65+), Tatebayashi clearly encompass the claimed limitation "configured to separately limit read and write access to the disk drive".

Regarding claim 45, see analysis of claim 30.

2. Claims 44 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (US 5909638) in view of Tatebayashi et al. (US 6182215 B1) and further in view of Peterson Jr. (US 5825876) and further in view of Abecassis (US 5696869).

Regarding claim 44, Allen, Tatebayashi and Peterson do not disclose wherein the controller comprises a data buffer configured to buffer data as the data is transferred to or from the disk drive.

Abecassis discloses wherein the controller comprises a data buffer configured to buffer data as the data is transferred to or from the disk drive (Col.10, lines 33-60). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Allen and Tatebayashi to have a data buffer configured to buffer data as the data is transferred to or from the disk drive, as taught by Abecassis, so to retrieve subsequent from information from the video disk without altering the transmission of the required frames per second to provide a transparently continuous video signal transmission, as suggested by Abecassis (Col. 10, lines 35-40).

Regarding claims 46 and 47, Allen and Tatebayashi do not disclose wherein the controller is configured to limit access to the mass storage module based at least upon a content rating of a content unit and a set of user preference relating to the format content units to be stored on the mass storage module.

Abecassis discloses the controller is configured to limit access to the mass storage module based at least upon a content rating of a content unit (Col. 10, lines 50- Col. 11, lines 15) and a set of user preference relating to the format content units to be stored on the mass storage module (Col. 11, lines 15-23).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Allen and Tatebayashi to limit access to the mass storage module based at least upon a content rating of a

content unit so to provide a video program that is highly responsive to viewer control over its content (see col. 5, lines 5-12).

3. Claims 48-51, 53, 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (US 5559549) in view of Peterson Jr. (US 5825876).

Regarding claim 48, Hendricks discloses a set-top box for accessing video content stored on a portable video content storage device, the set-top box comprising:

A receptacle configured to receive the portable video content storage device, wherein the portable video content storage device can be inserted and removed by a user (Fig. 5a, element 635; Col. 15, lines 8-14);

A video decoder module configured to decode the video content to produce an output signal; and a processor configured to control the video decoder module (Fig. 4 and fig. 6); Col. 14, lines 21-60)

Hendricks does not clearly disclose a processor configured to accumulate present content use data based at least upon an amount use of the video content and to store the accumulated content use data onto the portable video content on the portable video content storage device.

Peterson discloses Fig. 1, a method of controlling access to a secured data content of a storage medium 10 and is configured to accumulate and write content use data to the "portable storage device" (secure card 42; Col. 8, lines 40-Col. 9, lines 10) through an authentication method. Therefore, it

would have been obvious to an ordinary skill in the art at the time the invention was made to modify Hendrick's STB to write content use data to a portable storage device, as suggested by Peterson, so to keep track and limit the usage/access of the content according to the authorized list 56 whereby revenue generation from distribution thereof is expended are desirable (Col. 2, lines 12-15 and Col. 10, lines 30-35).

Regarding claim 49, Hendricks further discloses wherein the processor is further configured to control the portable video content storage device (Col. 15, lines 35-50).

Regarding claim 50, Hendricks further discloses a decryption module (Fig. 4, element "Decrypt".)

Regarding claim 51, Hendricks further discloses a translation module configured to translate a non-standard communication protocol used by the portable video content storage device (SCSI) into an industry standard communications protocol (Col. 15, lines 40-65+).

Regarding claim 53, Hendricks further discloses wherein the output signal comprises video information and audio information (see Fig. 4).

Regarding claims 57 -59, the method claims 57 – 59 are analyzed with respect to claim 48.

4. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (US 5559549) in view of Peterson Jr. (US 5825876), and further in view of Tatebayashi et al. (US 6182215 B1).

Regarding claim 52, Hendricks and Peterson do not clearly disclose the STB further comprising an authentication module configured to provide authentication information to the portable video content storage device.

Tatebayashi discloses an STB's authentication module configured to provide authentication information to the portable video content storage device (Fig. 5; elements 101 and Fig., 2; elements 104, 105, 106, 102, 103). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks's system to securely configure the authentication of the portable video content storage, as taught by Tatebayashi, so to prevent the video productions/recording from being distributed to unauthorized devices (Col. 1, lines 47-50).

5. Claims 54 -56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (US 5559549) in view of Peterson Jr. (US 5825876), and further in view of Abecassis (US 5696869).

Regarding claims 54-56, Hendricks and Peterson do not disclose wherein the processor is further configured to access user preferences stored on the portable video content storage device based at least upon a content rating of the content unit and to modify the user references.

Abecassis discloses the processor of a Video disk player is further configured to access user preferences stored on the portable video content storage device based at least upon a content rating of the content unit and to

modify the user references, (Col. 9, lines 53-Col. 10, lines 32; Col. 10, lines 50-col. 11, lines 15; Col. 11, lines 15-23).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Hendricks and Peterson to configured to access user preferences stored on the portable video content storage device based at least upon a content rating of the content unit and to modify the user references, so to provide a video program that is highly responsive to viewer control over its content (see col. 5, lines 5-12).

6. Claims 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (US 5559549) in view of Peterson Jr. (US 5825876) and further in view of Russo (US 5619247).

Regarding claim 60, Hendricks and Peterson do not clearly disclose the content use data comprises a listing of executed user commands.

Russo discloses the content use data comprises a listing of executed user commands (Col. 9, lines 38- col. 10, lines 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks and Peterson's to incorporate a listing of executed user commands along with the content use data, as taught by Russo, so to enhance the tracking of the usage/access of the content by triggering of account debit at different points in time associated with the selection of the desired program (Col. 10, lines 15-20).

Regarding claim 61, Russo further discloses the content use data associates a number of uses with a portion of the video content (Col. 10, lines 10-22).

7. Claims 39- 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cantone (US 5734781) in view of Tatebayashi et al. (US 6182215 B1).

Regarding claim 39, Cantone fails to show the communication port comprise an optical connector.

Official Notice is taken that the use of an optical connector is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cantone by including an optical connector so to provide a more choice of connectivity between devices.

Regarding claims 40, Cantone does not clearly discloses the controller is configured to authenticate the Kiosk.

Tatebayashi discloses an authentication scheme to communicate with only devices that have a reference authentication table pre-configured (Col. 5, lines 65-Col. 6, lines 60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cantone's device by configuring the controller to authenticate the kiosk, as taught by Tatebayashi, so to prevent the video productions/recording from being distributed to unauthorized devices (Col. 1, lines 47-50).

Regarding claim 41, in combination with the analysis of claim 40, it is Cantone further discloses the controller is further configured to enable video content to be read from mass storage module 12 by a compatible configured reproduction device VCR (Col. 4, lines 35-48). Tatebayashi shows a STB connects to a VCR for reproducing video content from a VCR (Fig. 2).

Regarding claim 43, with the teaching of Tatebayashi ' authentication protocols (Col. 8, lines 15-65+), Tatebayashi clearly encompass the claimed limitation "configured to separately limit read and write access to the disk drive".

8. Claims 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cantone (US 5734781) in view of Tatebayashi et al. (US 6182215 B1) and further in view of Abecassis (US 5696869).

Regarding claims 46 and 47, Cantone and Tatebayashi do not disclose wherein the controller is configured to limit access to the mass storage module based at least upon a content rating of a content unit and a set of user preference relating to the format content units to be stored on the mass storage module.

Abecassis discloses the controller is configured to limit access to the mass storage module based at least upon a content rating of a content unit (Col. 10, lines 50- Col. 11, lines 15) and a set of user preference relating to the format content units to be stored on the mass storage module (Col. 11, lines 15-23).



Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Allen and Tatebayashi to limit access to the mass storage module based at least upon a content rating of a content unit so to provide a video program that is highly responsive to viewer control over its content (see col. 5, lines 5-12).

**Contact Fax Information**

**Any response to this action should be mailed to:**

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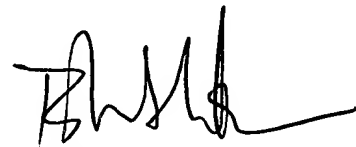
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (703) 308-7372. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5399.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

HT:ht  
7/28/02



Bhavesh Mehta  
Primary Examiner